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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/314,262 05/18/99 VIERK

S A-66435/JAS/

IM22/0913
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EXAMINER

RESAN, S

ART UNIT

PAPER NUMBER

1773

8

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/314262

Applicant(s)

VIERK el al

Examiner

RESW

Group Art Unit

1773

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 6-22-01☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-3, 5, 7-9, 11-17, 19

is/are pending in the application.

Of the above claim(s)

is/are withdrawn from consideration.

☐ Claim(s)

is/are allowed.

☒ Claim(s) 1-3, 5, 7-9, 11-17, 19

is/are rejected.

☐ Claim(s)

is/are objected to.

☐ Claim(s)

are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to claim 5 is deemed to have introduced new matter.

Note page 4, teaches that Reinforcing agents include anisotropic fillers and isotropic fillers however mineral particles are specifically cited as an isotropic filler and is therefore an isotropic reinforcing agent and cannot be present in the Markush group of claim 5

4. Claims 1-3, 5, 7-9, 11-17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuromiya et al in view of Landin for the reasons of record and as discussed below.

5. Applicant's arguments filed 6-22-01 have been fully considered but they are not persuasive.

Applicants have amended the claims and argue that the present claims are not obvious under 35 USC103 in view of Kuromiya and Landin.

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Applicants argue that their claimed composite material is filled with viscoelastic damping particles, anisotropic reinforcing agents or combination thereof while Kuromiya et al only teaches spherical shaped filler particles.

In response, the examiner points out that while the spherical shaped filler particles of Kuromiya et al are not anisotropic reinforcing agents, they may be broadly considered viscoelastic damping particles. Furthermore, Kuromiya et al do not exclude nonspherical particles from their invention (see for example mica-col. 6, line 17) but only set it forth as a preferred embodiment.

Applicants argue that the one or more internal damping layers of Landin are positioned between the structural material of the rotatable storage article and are constructed of a viscoelastic rubber, thermoplastic material or thermosetting resin but do not suggest applicants invention in which the substrate comprises at least one composite material exhibiting a modulus of about \geq 350 Kpsi wherein the plastic composite material is filled with viscoelastic particles, anisotropic reinforcing agents or combinations.

However, applicants have only focused upon one embodiment of ^{LANDIN} Kuromiya. At col. 6, lines 59-67, however, ^{LANDIN} Kuromiya teach that the viscoelastic damping materials may be members of a ^(CLAIM LANGUAGE) Markush group which include as members "plastic composite materials", e.g., polycarbonate which is also listed as a structured ²¹ material by ^{Landin Re 36,806} Kuromiya (col. 5, line 6). The polycarbonate when ^d used as a viscoelastic damping material ^{may} have "an effective amount of a fiber on and/or particulate material" (col. 7 lines 23-26). The examiner maintains that the combination with Kuromiya et al is not precluded since it would have been obvious to one of ordinary skill in the art

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that the thermoplastic norborene could be used as either the structural or vibration damping "plastic composite material" of Landin since the thermoplastic norborine is a functional equivalent to polycarbonate for disk substrates and use as an engineering plastic. Finding the members of a ²⁵⁵clear of prior art polymer which are best suited for a particular purpose is not a patentable invention. Ex parte Fauser (POBA 1953).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (703) 308-4287. The examiner can normally be reached on Tuesday--Friday from 7:30 a.m. to 6:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau , can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

S.A. Resan/dh

September 11, 2001



STEVAN A. RESAN
PRIMARY EXAMINER